

REMARKS

This is a full and timely response to the non-final Office Action mailed on May 7, 2003. Reexamination and reconsideration in light of the above amendments and the following remarks are courteously requested.

Claims 1-114 are present within the above-identified application, with claims 19-114 being withdrawn from consideration by the Examiner. No new matter has been added.

Allowable subject matter

Appreciation is expressed for the indication that claims 11-17 contain allowable subject matter.

Claim objections

In response to the claim objections, claims 4 and 10 have been amended. Withdrawal of these objections is respectfully requested.

Rejections under 35 U.S.C. §112

Claims 7-8 and 14-15 were rejected under 35 U.S.C. §112, second paragraph.

The Office Action contends that the language found within claims 7-8 and 14-15 lack clarity.

In response to this contention, claims 7 and 14 include the feature of the first optical material comprising 1) titanium oxide, 2) tantalum oxide, 3) gallium phosphate, 3) gallium nitride, 5) a compound of titanium, niobium, and oxygen, 6) a compound of titanium, tantalum, and oxygen, or 7) silicon nitride. Thus, the claim language found within claims 7 and 14 is clear.

In response further to this contention, claims 8 and 15 include the feature of the second optical material comprising 1) titanium oxide, 2) tantalum oxide, 3) gallium phosphate, 4) gallium nitride, 5) a compound of titanium, niobium, and oxygen, 6) a compound of titanium, tantalum, and oxygen, or 7) silicon nitride. Thus, the claim language found within claims 8 and 15 is clear.

Withdrawal of this rejection and allowance of the claims is respectfully requested.

Claim 18 was rejected under 35 U.S.C. §112, second paragraph.

The Office Action contends that the language found within claim 18 lacks clarity.

While not conceding the propriety of this rejection and in order to advance the prosecution of this application, claim 18 has been amended. Withdrawal of this rejection and allowance of the claims is respectfully requested.

Rejections under 35 U.S.C. §102 and §103

Claims 1-6, 9 and 18 were rejected under 35 U.S.C. §102 as being allegedly anticipated by U.S. Patent No. 3,532,038 to Rottmann.

Claims 1 and 5-7 were rejected under 35 U.S.C. §102 as being allegedly anticipated by U.S. Patent No. 4,606,750 to Torii et al. (Torii).

These rejections are traversed at least for the following reasons.

Claims 1-7

Claims 1-7 include the features of:

a first optical portion made of a first optical material and having a concavity;

a second optical portion comprising a second optical material having a refractive index different from that of the first optical material, and disposed within said concavity; and

a third optical portion comprising a transparent third optical material, said first optical portion being between said second and third optical portions.

However, both Rottmann and Torii fail to disclose, teach or suggest a third optical portion comprising a transparent third optical material, wherein the first optical portion is between the second and third optical portions.

Withdrawal of these rejections and allowance of the claims is respectfully requested.

Claims 9 and 18

While not conceding the propriety of this rejection and in order to advance the prosecution of this application, claim 9 has been canceled and claim 18 has been amended to depend from claim 10.

Withdrawal of this rejection and allowance of the claims is

respectfully requested.

Claims 1-2, 4-6, 9-10 and 18 were rejected under 35 U.S.C. §102 as being allegedly anticipated by (U.S. Patent Application No. US 2002/0027715) to Shimizu et al. (Shimizu).

This rejection is traversed at least for the following reasons.

With regard to Shimizu, this reference is **not prior art** to the Applicant's invention. Shimizu is based on an application filed on April 10, 2001. The Applicant's invention has an effective priority date of April 27, 1997. Accordingly, withdrawal of this rejection is respectfully requested. See M.P.E.P §201.15.

Withdrawal of this rejection and allowance of the claims is respectfully requested.

Claim 3 was rejected under 35 U.S.C. §103 as being allegedly obvious over Rottmann.

This rejection is traversed at least for the following reasons.

The Office Action admits that Rottmann does not teach the second optical portion comprising an optical oil or a liquid crystal. But the Office Action asserts, without providing supporting evidence, that the skilled artisan would have provided a second optical portion comprising an optical oil or a liquid crystal. However, this unsupported assertion amounts to nothing more than conclusions that are personal in nature.

In this regard, the teachings, suggestions or incentives supporting the obviousness-type double patenting rejection must be clear and particular. Broad conclusory statements, standing alone, are not evidence. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

As a rule, "assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference." (Citations omitted). *In re Pardo and Landau*, 214 USPQ 673, 677 (CCPA 1982). The support must have existed at the time the claimed invention was made. *In re Merck & Co., Inc.*, 231 USPQ 375, 379 (Fed. Cir. 1986).

"Allegations concerning specific 'knowledge' of the prior

art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge." (Citations omitted). *In re Pardo and Landau*, 214 USPQ 673, 677 (CCPA 1982).

In addition, "it is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the applicant's combination would have been obvious" (citations omitted). *In re Gorman*, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). See also *In re Dembiczak*, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999) (rejection based upon hindsight is reversed).

Moreover, the procedures established by Title 37 of the Code of Federal Regulations expressly entitle the Applicant to an Examiner's affidavit upon request. Specifically, "when a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons." 37 C.F.R. 1.104(d)(2).

Also note that the failure to provide any objective evidence to support the challenged use of Official Notice constitutes **clear and reversible error**. *Ex parte Natale*, 11 USPQ2d 1222, 1227-1228 (Bd. Pat. App. & Int. 1989).

Accordingly, **Applicant hereby requests a reference or an Examiner's affidavit** to support this officially noticed position of obviousness or what is well known. Further note that if this reference or Examiner's affidavit is not provided, the assertions of what is well known **must be withdrawn**. See M.P.E.P. 2144.03.

In addition, this assertion amounts to nothing more than an "obvious-to-try" situation. Specifically, "an 'obvious-to-try' situation exists when a general disclosure may pique the scientist's curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued." *In re Eli Lilly & Co.*, 14 USPQ2d 1741, 1743 (Fed. Cir. 1990). Moreover, "an invention is 'obvious to try' where the prior art gives either no indication of which parameters are critical or no direction as to which of many possible choices is likely to be successful." *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 10 USPQ2d 1843, 1845 (Fed.

Cir. 1989).

Here, Rottmann does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued. "Obvious to try" is not the standard under §103. *In re O'Farrell*, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988).

Withdrawal of this rejection and allowance of the claims is respectfully requested.

Claim 8 was rejected under 35 U.S.C. §103 as being allegedly obvious over Torii in view of U.S. Patent No. 5,483,614 to Brück et al. (Brück).

These rejections are traversed at least for the following reasons.

Claim 8, which is dependent upon claim 1, includes the features of:

a first optical portion made of a first optical material and having a concavity;

a second optical portion comprising a second optical

material having a refractive index different from that of the first optical material, and disposed within said concavity; and

a third optical portion comprising a transparent third optical material, said first optical portion being between said second and third optical portions.

However, both Torii and Brück fail to disclose, teach or suggest a third optical portion comprising a transparent third optical material, wherein the first optical portion is between the second and third optical portions.

Withdrawal of this rejection and allowance of the claims is respectfully requested.

Conclusion

For the foregoing reasons, all the claims now pending in the present application are allowable, and the present application is in condition for allowance. (original) Accordingly, favorable reexamination and reconsideration of the application in light of the amendments and remarks is courteously solicited.

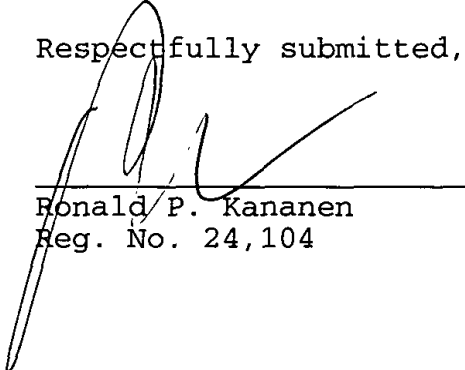
If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone Brian K. Dutton, Reg. No. 47,255, at 202-955-8753, or the undersigned attorney.

If any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Respectfully submitted,

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